



EPW

PATENT
Customer No. 22,852
Attorney Docket No. 05725.1008-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Jerome PEYRELEVADE et al.) Group Art Unit: 3625
)
Application No.: 10/024,355) Examiner: James H. ZURITA
)
Filed: December 21, 2001)
)
For: METHODS AND SYSTEMS)
INVOLVING SIMULATED)
APPLICATION OF BEAUTY)
PRODUCTS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

In an Office Action dated April 1, 2005, the Examiner required a restriction under 35 U.S.C. § 121, and requested an election of one of the following claim groupings:

- Grouping I: Claims 1-21, drawn to a beauty product selection method;
- Grouping II: Claims 22-35, drawn to a method of simulating beauty production application;
- Grouping III: Claims 36-54, drawn to a beauty product selection system;
- Grouping IV: Claims 55-67, drawn to a system for simulating beauty product application;
- Grouping V: Claims 68-71, drawn to a beauty product selection method; and

Grouping VI: Claim 72, drawn to a beauty product selection method.

Further, the Examiner designated groups of the above Groupings, as follows:

Group I consisting of Groupings I, II, V, and VI, directed to methods; and Group II consisting of Groupings III and IV, directed to systems. The Examiner also asserted that Group I and Group II are related as process and apparatus for its practice.

Within Group I, the Examiner alleged that:

1. Groupings I and II are related as combination and sub-combination;
2. Groupings I and V are related as combination and sub-combination;
3. Groupings I and VI are related as combination and sub-combination;
4. Groupings II and V are related as combination and sub-combination;
5. Groupings II and VI are related as combination and sub-combination; and
6. Groupings V and VI are related as combination and sub-combination.

Within Group II, the Examiner alleged that Groupings III and IV are related as sub-combinations disclosed as usable together in a single combination.

Finally, the Examiner requested an election of one of the following asserted species if one of Groupings I to V is elected:

Grouping I

I.a	Claims 1, 2, 18, 19, 20	I.h	Claims 1, 10, 11
I.b	Claims 1, 2, 4	I.i	Claims 1, 10, 12
I.c	Claims 1, 2, 6	I.j	Claims 1, 13, 14
I.d	Claims 1, 3	I.k	Claims 1, 15, 16
I.e	Claims 1, 5	I.l	Claims 1, 17
I.f	Claims 1, 7, 8	I.m	Claims 1, 21
I.g	Claims 1, 7, 9		

Grouping II

- | | | | |
|------|-------------------|------|-------------------|
| II.a | Claims 22, 23, 24 | II.e | Claims 22, 29, 30 |
| II.b | Claims 22, 25, 26 | II.f | Claims 22, 31 |
| II.c | Claims 22, 25, 27 | II.g | Claims 22, 32 |
| II.d | Claims 22, 28 | | |

Grouping III

- | | | | |
|-------|---------------------------|-------|-----------------------|
| III.a | Claims 36, 37, 38, 39, 40 | III.f | Claims 36, 41, 48 |
| III.b | Claims 36, 41, 42 | III.g | Claims 36, 41, 50 |
| III.c | Claims 36, 41, 43 | III.h | Claims 36, 51 |
| III.d | Claims 36, 41, 45 | III.i | Claims 36, 51, 53, 54 |
| III.e | Claims 36, 41, 46 | | |

Grouping IV

- | | | | |
|------|-------------------|------|-------------------|
| IV.a | Claims 55, 56, 57 | IV.e | Claims 55, 62, 63 |
| IV.b | Claims 55, 58, 59 | IV.f | Claims 55, 64 |
| IV.c | Claims 55, 58, 60 | IV.g | Claims 55, 65, 66 |
| IV.d | Claims 55, 61 | IV.h | Claims 55, 65, 67 |

Grouping V

- | | | | |
|-----|-------------------|-----|---------------|
| V.a | Claims 68, 69, 70 | V.b | Claims 68, 71 |
|-----|-------------------|-----|---------------|

Applicants respectfully submit that the restriction and election requirements should be withdrawn for the following reasons.

Turning first to the restriction requirement, Applicants respectfully request that the requirement for restriction be withdrawn because claim Groupings I to VI do not have the combination and sub-combination relationships alleged in the Office Action. "A combination is an organization of which a sub-combination or element is a **part**." M.P.E.P. § 806.05(a) (emphasis added). Claim Grouping I, and claim Groupings II, V, and VI are not related as combination and sub-combinations because the methods in

Groupings II, V, and VI are not a part of the method in Grouping I. For example, claims Groupings I, V, and VI all generally relate to a beauty product selection method (see the preambles of claims 1, 68, and 72) and, thus, concern **combinations** having commonality with one another, not combination/sub-combinations. Similarly, claim Grouping II, and claim Groupings V and VI are not related as combination and sub-combinations because the methods in Groupings V and VI are not a part of the method in Grouping II. Also, claim Groupings V and VI are not related as combination and sub-combination because the method in Grouping VI is not a part of the method in Grouping V. Finally, Groupings III and IV are not related as sub-combinations usable together because those Groupings relate to combinations, namely systems for beauty products, rather than separate sub-combinations. Since the claim Groupings lack the combination and sub-combination relationships alleged in the Office Action, the restriction requirement should be withdrawn.

Furthermore, the restriction requirement should be withdrawn because there would be no serious burden if all of the claims would be examined together. "If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). The claimed subject matter relates to simulating a beauty product on a facial image. The search required to properly examine the claims of one of Groupings I to VI would necessarily overlap a search required to properly examine the claims of the remainder of Groupings I to VI. For example, the Office Action acknowledges that Groupings II and IV and Groupings V and VI would be classified in the same class and subclass and, thus, have

an overlapping search. Accordingly, it would not constitute an undue burden to search all of the claim Groupings together. Consequently, the restriction requirement should be withdrawn.

Applicants also submit that the election of species requirements should be withdrawn because the Office Action improperly designates alleged species by identifying claims rather than identifying different disclosed embodiments. *"Claims are never species.... Species are always the specifically different embodiments."* M.P.E.P. § 806.04(e) (emphasis in original). Furthermore, the election of species requirement is improper because using claims to designate species is only permitted when species cannot be conveniently identified through drawing figures, examples, etc. M.P.E.P. § 809.02(a). The Office Action fails to set forth any need for using claims to designate alleged species.

Moreover, the election of species requirement should be withdrawn inasmuch as the alleged species are not disclosed as being mutually exclusive from one another. (See M.P.E.P. § 806.04(f).) For example, certain disclosed embodiments could include combinations of all of the claims of any of Groupings I to VI. The limited species designations in the Office Action are clearly improper because they do not provide Applicants with the opportunity to elect such combination species. Therefore, the election of species requirement should be withdrawn.

Applicants respectfully request that the Examiner reconsider and withdraw the restriction and election of species requirements in light of at least the reasons set forth above. To be fully responsive to the Office Action, Applicants provisionally elect claim Grouping I and species I.a (consisting of claims 1, 2, 18, 19, and 20) **with traverse**. If

the Examiner declines to withdraw the restriction and election of species requirements, Applicants request the Examiner to acknowledge this traversal and to indicate the finality of the requirements so that Applicants will be able to submit a Petition under 37 C.F.R. § 1.144 requesting review of these requirements.

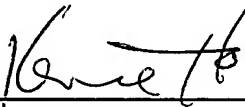
Finally, Applicants note that the Office Action contains numerous statements reflecting apparent assertions concerning the claims. Regardless of whether any such statement is addressed specifically herein, Applicants decline to subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 1, 2005

By: 
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